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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,036	03/25/2004	Neil Andrew Abercrombie Simpson	CRUI/0011	5819

7590 08/28/2006

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EXAMINER
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LE, HUNG CHARLIE

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/809,036	SIMPSON ET AL.	
	Examiner	Art Unit	
	Hung C. Le	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 89 is/are pending in the application.
- 4a) Of the above claim(s) 22 - 25, 42, 45, 47, 56, 68 - 69, 73 - 75, 79 - 81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 - 89 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 05/15/2006, with respect to claims 1 – 89, have been fully considered. Upon further review of the claims, the examiner noted that there is a plurality of distinct inventions claimed by the applicant. Therefore a restriction and election of species is required.

Note: Claims 22 – 25, 42, 45, 47, 56, 68 – 69, 73 – 75, and 79 – 81 were cancelled by applicant.

### ***Election/Restrictions***

2. Restriction to one of the following invention is required under 35 U. S. C. 121:
  - I. Claims 1 – 56, 82 – 86, drawn to a method of expanding tubing, classified in Class 72, subclass 370.06.
  - II. Claims 57 – 81, 87 – 89, drawn to an apparatus for expanding tubing, classified in class 72, subclass 370.08.

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3. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case: The apparatus as claimed can be used to practice another and different process. Such as to expanding any non-tubing container.

4. Upon election of either one of the inventions I or II above, the applicant is further required under 35 U. S. C. 121 to elect **one of each of the following disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claims is finally held to be allowed:

A. Vibration direction (claim 6). Example: Random only or random and axial only.

B. Expansion device Vibration:

(i) Major portion of the expansion device is subject to vibration (claim 7).

(ii) Selected portion of the expansion device is subjected to vibration (claim 8).

C. Vibration of component:

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- (i) Substantial portion of the tube is vibrated (claim 11).
- (ii) Selected portion of the tube is vibrated (claim 12).

D. Form of vibration:

- (i) Vibration induces physical movement (claim 15).
- (ii) Vibration induces contraction and expansion (claim 16).

E. Vibration creation:

- (i) Vibration is created locally (claim 18).
- (ii) Vibration is created remotely (claim 19).

F. Source of vibration coupling:

- (i) Directly coupling (claim 27).
- (ii) Indirectly coupling (claim 28).

G. Vibration amplitude , frequency & form (claims 29, 30 & 31). For example:

Constant only or varying and random only.

H. Vibration is:

- (i) High frequency <sup>ONLY</sup> (claim 32).
- (ii) Ultrasonic (claim 33).
- (iii) Electromagnetic (claim 35).

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(iv) Low frequency<sup>only</sup> (claim 36).

(v) Low and High frequency (claim 39).

I. Vibration is selected to:

(i) Coincide with a natural frequency of the expansion device (claim 40).

(ii) Avoid a natural frequency of the expansion device (claim 41).

J. Expansion device is:

(i) In sliding contact with the tube (claim 46).

(ii) Translated axially relative to the tube (claim 48).

(iii) Translated rotationally relative to the tubing (claim 49).

5. ***NOTE that a single species election must be closed-ended (e.g., consisting of) not be open ended (e.g., comprising).***

***Applicant is advised that an open-ended election will be considered non responsive.***

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse.

To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

**Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case.** In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from The Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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8/21/06



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SUPERVISORY PATENT EXAMINER